

REMARKS

Applicants have combined the canceled claims into Claim 1. This results in a system have substantially more elements present which should result in patentability thereof.

The Examiner is respectfully requested to reconsider the rejection of Claims 1 - 12, 14, and 16 - 20 under 35 U.S.C. §103(a) as being unpatentable over Levi (United States Patent 6,636,983) in view of Rowland, (United States Patent 6,405,318).

In analyzing the Levi and Rowland references cited, it is questionable whether and why the skilled artisan would look to supplement the teaching of the Levi primary reference. The Examiner concedes that there are elements found in Applicants' claims which are not disclosed in Levi.

Considering what are the essential features of each of the inventions in these patents, the skilled artisan would not instinctively take the isolated disclosures of "logout" and the "logout anomaly detector" of Rowland and add it to the overall teaching of the Levi reference. There is no suggestion in Levi that his system as disclosed is unsuitable which would warrant the combination with the Rowland reference.

The lack of appropriate commonality of the disclosures in the two inventions cited as prior art as applied to the present invention serves to rebut the rejection of the claims under 35 U.S.C. 103. Applicants submit that the prior art does not allow or support the conclusion of obviousness that the Examiner seeks to establish.

The references to Levi and Rowland contain disclosures that if and when combined, do not support each other. It appears from a review of the references that if and when an element in any arbitrary system is included in Rowland, the Examiner is asserting that these Elements, without more, are suitable to render obvious the present invention.

The references as cited, alone, or in combination, do not disclose or even imply the structure of the mouse of the present invention. In the rejection, the Examiner is selectively picking and choosing individual elements disclosed in the references to the exclusion of what both of the references as a whole teach to one skilled in the art. For example, to arrive at Applicants' invention, the person skilled in the art would have to randomly pick and choose among a myriad number of different features found in Rowland with the only guidance as to what to select being provided by Applicant's disclosure since Levi does not teach the same type of intrusion system. Based upon the skilled artisan's reading and knowledge of the systems disclosed and their respective objectives and how they are implemented, it is unlikely that the person skilled in the art would use Rowland in combination with Levi, and *vice versa*.

In order to analyze the propriety of the Examiner's rejections in this case, a review of the pertinent applicable law relating to 35 U.S.C. § 103 is warranted. The Examiner has applied the two references discussed above using selective combinations to render obvious the invention.

The Court of Appeals for the Federal Circuit has set guidelines governing such application of references. These guidelines are, as stated are found in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ, 543, 551:

When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself.

A representative case relying upon this rule of law is Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1434 (Fed. Cir. 1988). The district court in Uniroyal found that a combination of various features from a plurality of prior art references suggested the claimed invention of the patent in suit. The Federal Circuit in its decision found that the district court did not show, however, that there was any teaching or suggestion in any of the references, or in the prior art as a whole, that would lead one with ordinary skill in the art to make the

combination. The Federal Circuit opined:

Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. [837 F.2d at 1051, 5 USPQ 2d at 1438, citing Lindemann, 730 F.2d 1452, 221 USPQ 481, 488 (Fed. Cir. 1984).]

The Examiner has selected certain elements as noted above from the cited Rowland reference for the sake of showing the individual elements claimed without regard to the total teaching of the two references.

The Examiner in his application of the cited references is improperly picking and choosing. The rejection is a piecemeal construction of the invention. Such piecemeal reconstruction of the prior art patents in light of the instant disclosure is contrary to the requirements of 35 U.S.C. § 103.

The ever present question in cases within the ambit of 35 U.S.C. § 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the teachings of the prior art at the time the invention was made. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. (Emphasis in original) In re Wesslau 147 U.S.P.Q. 391, 393 (CCPA 1965)

This holding succinctly summarizes the Examiner's application of references in this case, because the Examiner did in fact pick and choose so much of the Rowland reference to support the rejection and did not cover completely in the Office Action the full scope of what these varied disclosure references fairly suggest to one skilled in the art.

Further, the Federal Circuit has stated that the Patent Office bears the burden of establishing obviousness. It held this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. [837 F.2d at 1075, 5 USPQ 2d at 1599.]

The court concluded its discussion of this issue by stating that teachings or references can be combined only if there is some suggestion to do so. In the present case, the skilled artisan, viewing the references would not be directed toward Applicant's device. There can reasonably be no system such as Applicants' emanating from the Levi and Rowland references, since the basic systems of the two references are different. There is no proper basis to combine them.

The Examiner is respectfully requested to reconsider the rejection of Claims 13 and 15 under 35 U.S.C. §103(a) as being unpatentable over Levi (United States Patent 6,636,983) in view of Rowland, (United States Patent 6,405,318), and further in view of Lambert, et al. (United States Patent 6,367,016).

The arguments presented above are hereby incorporated by reference in response to the aforesaid rejection. There is no suggestion in Levi that warrants its combination with Rowland and Lambert. Again the Examiner is pick and choosing specific elements disclosed in Lambert with no basis for doing so other than to disclose elements to the total exclusion of what the reference teaches as a whole.

The Examiner is requested to allow this case as a result of the aforementioned Amendments to the claims and the cancellations thereof..

Respectfully Submitted,

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I hereby certify that this paper is being mailed via the United States Postal Service, first class mail, on the date indicated below addressed to the Commissioner of Patents and Trademarks, Post Office Box 1450, Alexandria, VA 22313-1450

Signature _____ Date: June 8, 2005
Thomas A. Beck